

### **REMARKS**

In the restriction requirement, Applicants elected Group V (claims 90-100) without traverse for examination. Claims 37-89, 101 have been canceled without prejudice. Applications reserve the right to file divisional applications for Groups 1-4 and Group 6, as allow by the rules.

#### **37 C.F.R. § 1.83 (a) -- Objections to Drawings**

The drawings were objected to under 37 C.F.R. 1.83(a) for not showing every feature specified in the claims. Applicants have also been advised that no new matter should be entered. By this amendment, new drawing Fig. 45 is canceled and amended drawing FIG. 4 is restored as the originally filed FIG. 4. Since the drawings are now the original drawings as filed, the issue of entering new matter with regard to the drawings is moot, and reconsideration is requested.

FIGS. 43 and 44 each show, schematically, the RFID tag 688 embedded in the file folder 52, or the RFID tag 688 in the process of being embedded in the file folder 52 during the manufacture of the file folder 52, (step 702, embedding the RFID tag and gluing).

According to 37 CFR §1.83(a), the drawings in a nonprovisional application must show every feature of the invention specified in the claims. However, *conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).*

As stated in the specification as filed, the principles of the present invention apply equally to any other file holder or other file storage means. Thus, element 52 should be understood to be a schematic representation of any well known document storage containers, including an x-ray jacket, a file box, or an envelope or carton designated for

storing paper files. Since the document storage containers of various types are all well known in the art, and each have seams, which are folded and glued, the schematic representation of a document storage container 52 fulfills the requirements of 37 C.F.R. § 1.83 (a) and reconsideration is requested.

**35 U.S.C. § 132 (a) -- Objections to Specification**

The amendment filed 8/27/2007 was objected to under 35 U.S.C. § 132 (a) because it introduces new matter into the disclosure. By this amendment, FIG. 4 has been restored as originally filed and new FIG. 45 has been deleted. In addition, the amendment to the specification, that specifically refer to the FIGS. 4 and 45 have been amended and restored as originally filed. In addition, the following statement has been added to the discussion of FIG. 44:

“As stated earlier on, the principles of the present invention apply equally to any other file holder or other file storage means. Thus, element 52 may be any well-known document storage container, including a file folder, an x-ray jacket, an envelope, or a file box designated for storing paper files.”

Support for this language comes earlier in the specification, on page 9, lines 11-14 of the application as filed. Since there is no new matter entered in the specification by amendment, reconsideration is requested.

**Rejection of Claims 90-100 for Double Patenting**

Claims 90-100 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No 6,758,802.

Applicants file herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the actual rejection. The rejection due to double patenting is therefore overcome, and claims 90-100 are allowable. Reconsideration is requested.

**35 U.S.C. § 112 -- Rejection of Claims 90-100**

Claims 90-100 are rejected under 35 U.S. C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The Examiner states that the Applicants have not sufficiently disclosed the folded and glued seam, in which the radio frequency identification tag is captured within. The structure of the folded and glued seam is not shown in Fig. 4 in relation to any other structures of the device. It is not known how the device is constructed.

Applicants respectfully disagree with the Examiner.

An adequate written description assures that those skilled in the art can “make and use the invention as claimed.” The specification need not disclose what is well known in the art. It is unnecessary to spell out every detail of the invention in the specification; only enough must be included to enable a person skilled in the art to make and use the invention as claimed without undue experimentation. Document storage containers (or file folders, or X-ray jackets, or file envelopes, or file boxes) and the methods of manufacturing these document storage containers are well-known in the art, and well known to persons skilled in the art. The process of making a document storage container by cutting a container blank from container stock, then folding and gluing the container blank, creating glued seams, is also well known to those skilled in the art.

The present Applicants were the first to recognize that trackable document storage containers could be created by inserting and embedding RFID tags in the glued seams during the process of folding and gluing of the container blanks, as claimed. The invention as claimed is not taught in the prior art.

In the present Office Action, the Examiner cites Christensen et al. (U.S. Patent No. 5,711,750) which is clearly available to those skilled in the art. In Christensen et al., the Examiner points out a die cut container blank (100) folded and glued to form an enclosure capable of containing documents; the container having at least one folded and glued seam (element 130 – See Fig. 13 embodiment). This reference, cited by the

Examiner, makes it clear that one skilled in the art would have knowledge of making a document storage container using folding and gluing and forming a glued seam. What is not known to one skilled in the art is the concept of embedding or capturing an RFID tag into the folded and glued seam, during the making of the document storage container, which is taught in the present application:

**Page 38, lines 26-28:** “In Fig. 43, the file folder 52 includes an RFID tag 688. In this embodiment, the RFID tag 688 is affixed to the file folder 52 in the manufacturing process by inserting the RFID tag 688 between the glued seams of a reinforced double-sided file folder.”

**Page 40, lines 15-16:** “The die cutting of the folder stock occurs at step 700. In the next step 702, the folder 52 is glued and, optionally, an RFID tag 688 is inserted.”

**MPEP 2164.01** states that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art.

According to 37 CFR §1.83(a), the drawings in a nonprovisional application must show every feature of the invention specified in the claims. However, *conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).* In the present specification, FIGS. 43 and 44 each show, schematically, the RFID tag 688 embedded in the file folder 52, or the RFID tag 688 in

the process of being embedded in the file folder 52 during the manufacture of the file folder 52, (step 702, embedding the RFID tag and gluing).

An information disclosure statement is submitted herewith for the purpose of identifying certain representative patents that teach the process of making document storage containers, including file folders, document storage envelopes, and document storage boxes. Each document storage container in the identified patents is made by the steps of die cutting a container blank, and folding and gluing the container blank (creating glued seams) to form a completed document storage container.

U.S. Patent No. 1,081,727 to Dunn shows and describes various configurations of file folders and reinforced file folders, in which a reinforcing flap is folded and pasted (glued) during manufacture.

U.S. Patent No. 1,743,191 to Charlton shows and describes a file folder, in which an edge strip is folded and glued over the file folder edge to provide reinforcement.

U.S. Patent No. 2,052,628 to Harby shows and describes a reinforced file folder and its method of manufacture. FIG. 5, in particular, shows the manufacturing process steps, including the steps of gluing and folding.

U.S. Patent No. 2,138,788 to Hart et al. shows and describes a manufacturing process for file folders that includes a gluing and folding step (page 4).

U.S. Patent No. 3,865,017 to Borski shows and describes a machine for making file folders, where the file folder blanks are folded and glued by the glue applying apparatus 16 (column 2, lines 10-12).

U.S. Patent No. 4,175,476 to Kidd shows and describes an apparatus and method for forming reinforced top file folders. FIG. 8, in particular, shows the step of applying glue and folding over a tab portion.

U.S. Patent No. 4,313,558 to Benham shows and describes an expandable envelope for holding documents that includes glue flaps. Glue flaps and glue areas are described (column 4, line 24-44).

U.S. Patent No. 4,531,667 to Meade shows and describes an expandable envelope file made from die cutting a blank, followed by folding and gluing to form a completed envelope.

U.S. Patent No. 5,494,161 to Herbst shows and describes a hanging folder file box in which a flap 100 is folded and secured to a third sidewall by means of glue (column 5, lines 55-63).

**35 U.S.C. § 112 -- Rejection of Claim 100**

Claim 100 stands rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the examiner states that there is insufficient antecedent basis for “document container stock” in line two. Claim 100 has been amended to substitute the wording “document storage container” for “document container stock,” which has clear antecedent basis in the claims. The rejection under 35 U.S.C. 112 is therefore overcome, and claims 100 is allowable. Reconsideration is requested.

**35 U.S.C. § 102 -- Rejection of Claims 90-99**

Claims 90-99 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bradford (US 5,908,135). The Examiner states that Bradford discloses a storage container capable of storing documents, comprising a die cut container blank (24) folded and glued to form an enclosure capable of containing documents; the container having at least one folded and glued seam (folded along score line 66 to form a two ply seam; and a radio frequency identification tag (104) captured within the glued portion of the seam.

The Applicants respectfully disagree.

For a claim to be anticipated under 35 U.S.C. § 102(b), the reference must disclose each and every limitation in the claim. Applicants respectfully submit that Bradford does not disclose every element of the claimed invention.

Bradford discloses a sleeve pack to be used with a pallet base and cover for shipping bulk goods, such as automobile parts or different assembly items. Bradford is directed to a different purpose than the present invention.

There is no suggestion that Bradford could be used as a document storage container. The sleeve pack is merely the sidewalls of a container. It does not form a complete container unless it is used with a pallet base and a cover. Therefore, Bradford can not be considered to be a document storage container.

The Bradford sleeve pack blank is formed from four pieces of corrugated plastic that are butt welded to form a complete blank. The blank is then folded along the score lines 66. In the last step of assembly of the sleeve pack, the vertical side edges of the blank are butt welded together in a non-overlapping edge-to-edge relationship.

The Bradford sleeve pack is not folded and glued as the examiner states. ***There is no discussion in Bradford of any folded and glued seams.*** Bradford uses edge-to-edge butt welded seams, without any overlap. Finally, the radio frequency identification tag is not captured within a glued portion of a seam, as presently claimed. In Bradford, ***the RFID tag is inserted in an embossed hole in the sidewall panel*** (column 7, lines 55-58).

The present invention allows for tracking of document storage containers, and provides a security feature. Because the RFID tags are hidden in the folded and glued seams of the document storage containers, their presence and location will be unknown to an observer, making it less likely that the RFID tag will be removed, and the document storage container stolen. In Bradford, the RFID tag is merely for identifying the contents of the sleeve pack, as a substitute for providing labeling on the sleeve pack. The RFID tag, mounted in the sidewall of the sleeve pack, is fully visible, and could easily be deactivated or removed.

Since Bradford does not disclose each and every limitation, the rejection based on anticipation under 35 U.S.C. § 102(b) is believed to be overcome, and reconsideration is requested.

**35 U.S.C. § 103(a) -- Rejection of Claim 100**

Claim 100 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradford (US 5,908,135). The Examiner states that Bradford discloses the claimed invention except for the printed identification information on the container, and that it is old and well known to include printed information on the outer surface of a container.

The Applicants respectfully disagree.

For the rejection under 35 U.S.C. § 103(a) to be proper, the references, either alone or in combination, must teach or suggest all of the claim limitations. Applicants respectfully submit that Bradford does not teach or suggest every element of the claimed invention.

As stated above, the Bradford reference does not teach or suggest folded and glued seams. There is no mention in Bradford of any glued seams. Also, the Bradford reference does not teach or suggest a radio frequency identification tag captured within a glued portion of a seam, as presently claimed. In Bradford, the RFID tag is inserted in an embossed hole in the sidewall panel (column 7, lines 55-58).

Furthermore, Bradford *teaches away* from the present invention. Column 2, lines 43-48 of Bradford states that: Since many sleeve packs are reusable it is undesirable to mark the sleeve pack in any permanent way. The next use of the sleeve pack may involve entirely different contents than the current shipment.

The sleeve pack of Bradford includes an RFID tag in its sidewall for the purpose of eliminating printed information on the sleeve pack, thus teaching away from Applicants' invention as claimed in claim 100. Bradford is clearly teaching away from including printed information on the outer surface of a container.

The Federal Circuit has recognized that a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Since the reference clearly teaches away from the concept of including printed information on a container, the rejection is believed to be overcome and reconsideration is requested.

**35 U.S.C. § 103(a) -- Rejection of Claim 90-100 – Christensen et al. and Bradford**

Claim 90-100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. (US 5,711,750) and Bradford (US 5,908,135). The Examiner states that Christensen et al. discloses a storage container (140) capable of storing documents, comprising a die cut container blank (110) folded and glued to form an enclosure capable of containing documents; the container having at least one folded and glued seam (element 130 – See Fig. 13 embodiment). The Examiner further states that Christensen discloses the claimed invention except for the radio frequency identification tag, and that it would have been obvious to have modified the storage container of Christensen with a radio frequency identification tag as taught by Bradford.

The Applicants respectfully disagree.

For the rejection under 35 U.S.C. § 103(a) to be proper, the references, either alone or in combination, must teach or suggest all of the claim limitations.

Neither Christensen et al. nor Bradford teach or suggest a radio frequency identification tag captured within the glued portion of a seam, as presently claimed. Once again, as stated above, the Bradford reference does not teach or suggest any folded and glued seams. There is no mention in Bradford of any glued seams, only butt-welded seams. Also, the Bradford reference does not teach or suggest a radio frequency identification tag captured within a glued portion of a seam, as presently claimed. In

Bradford, the RFID tag is inserted in an embossed hole in the sidewall panel (column 7, lines 55-58).

Since neither Christensen et al. nor Bradford, alone or in combination, teach or suggest all of the claim limitations, the rejection under 35 U.S.C. § 103(a) is believed to be overcome, and reconsideration is requested.

Furthermore, with regard to the rejection of claim 100, Bradford *teaches away* from the present invention. Column 2, lines 43-48 of Bradford states that: Since many sleeve packs are reusable it is undesirable to mark the sleeve pack in any permanent way. The next use of the sleeve pack may involve entirely different contents than the current shipment.

Since the Bradford reference clearly teaches away from the concept of including printed information on a container, the rejection is believed to be overcome and reconsideration is requested.

### Conclusion

In view of the amendments to the drawings and specification and the remarks, Applicants respectfully request withdrawal of all grounds of rejection. Applicants respectfully submit that all pending claims are now in condition for Allowance reconsideration is requested.

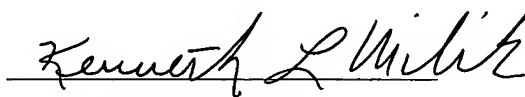
Respectfully submitted,

Date: March 15, 2008

Reg. No.: 30,963

Tel. No.: (978) 835-0240

Fax No.: (978) 371-0102



Kenneth Milik

Agent for Applicants

143 Martin Street

Carlisle, MA 01741